



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,996	03/03/2004	Carmen Flosbach	FA1013 US DIV	4286

23906 7590 06/09/2006

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
----------	--------------

1762

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/791,996	FLOSBACH ET AL.	
	Examiner	Art Unit	
	Elena Tsoy	1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Advisory Action

1. The Request for Reconsideration filed on 5/16/2006 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance for the reasons of record set forth in the Final Office Action mailed on 2/13/2006.

Response to Arguments

2. Applicants' arguments filed 5/16/2006 have been fully considered but they are not persuasive.

(A) Applicants argue that a hydroxyl-functional binder of Duecoffre is based on a hybrid polymer system of methacrylic copolymer and a hydroxy-functional polyester. Further, the methacrylic copolymer is prepared in the presence of the polyester polyol. The hybrid polymers used in Duecoffre are different from a simple physical mixture of a methacrylic copolymer and polyester polyol, as seen in the present invention. The Examiner suggests that the polyester described in Duecoffre is similar to the polyester polyol (a) of the present invention. However, Duecoffre's clear coat does not contain a polyester polyol, but instead contains a hybrid binder comprising polyester polyol as one part, and the methacrylic acid as the second part.

The Examiner respectfully disagrees with this argument. First of all, Duecoffre clearly teaches all components of claimed invention including B) separately from A) (See column 1, lines 41-60). Secondly, Duecoffre's clear coat does contain 80 wt % -60 wt % or less of a polyester polyol (a) of present invention, **in addition** to a hybrid binder comprising e.g. **at least** 20 wt % -40 wt % polyester polyol as one part in which the second part (i.e. the (meth)acrylic copolymer portion) has been prepared by free-radical polymerization (See Abstract; column 1, lines 61-67; column 2, lines 34-36). Moreover, **claims 11 and 12 do not recite negative limitation about a hybrid binder**, i.e. the hybrid binder is not excluded from the composition of claims 11 and 12. See Tables and Example 5 and 6. Example 5 describes a simple physical mixture of a hybrid binder A of Example 3 **and** polyester polyol B of Example 1. Example 6 describes a simple physical mixture of a hybrid binder A of Example 4 **and** polyester polyol B of Example 1.

Art Unit: 1762

(B) Applicants argue that Duecoffre does not teach the claimed quantitative composition of components (a1) and (a2) of the present invention, which require that the hydroxyl components and carboxyl components comprise no more than 20 wt-% of at least one diol and at least one monocarboxylic acid, respectively. To the contrary, Example 1 of Duecoffre comprises 57.8 M-% of monocarboxylic acid (isononanoic acid) among the carboxyl components and Example 2 of Duecoffre comprises 57 wt-% diol (hexane diol) among the hydroxyl components. In these Examples, both values (the 57.8 wt-% and 57 wt-%) are far above the upper limit disclosed in the present invention, which is 20 M-% in either case. This upper limit is set at 20 wt-% to ensure the high level of hydroxyl-functionality of the final polyester of the present invention.

The Examiner respectfully disagrees with this argument. First of all, it is held that patents are relevant as prior art for all they contain. NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART. **Disclosed examples** and preferred embodiments do **not** constitute a **teaching away** from a **broad** disclosure or nonpreferred embodiments. See MPEP 2123. Therefore, examples 1 and 2 of Duecoffre do not teach away from a **broad** disclosure where amounts of claimed a1 and a2 are within claimed range, i.e. Duecoffre does teach the claimed quantitative composition of components (a1) and (a2).

(C) Applicants argue that although Duecoffre teaches that 0 to 40 wt% of dihydric alcohols of molecular weight range 62 to 2000 Da, and 0 to 60 wt% of monocarboxylic acid of molecular range 112 to 600 Da are used for preparing polyester polyols (See col. 14, lines 40-65), it neither gives a specific example that is within a claimed range of 0 to 20% of monocarboxylic acid component (corresponding to element (a2) in Claims 11 and 12), nor does it give a specific example that is within a claimed range of 0 to 20% of a diol (corresponding to element (a1) in Claims 11 and 12), as claimed by the present invention. According to MPEP 2131.03 (II)-Anticipation of Ranges, "When the **prior art** discloses a **range** which. . .overlaps. . . **the claimed range**, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation".

Art Unit: 1762

The Examiner respectfully disagrees with this argument. First of all, Duecoffre discloses a range which **covers** NOT **overlaps** the claimed range. The claimed range of **0 to 20%** is **within** the Duecoffre's range of **0 to 40 wt% or 0 to 60 wt%**.

It is held that "anticipation" requires that every element of the claims appear in a single reference. Therefore, Duecoffre teaching claimed range anticipates the claims.

(D) Applicants submit that a prima facie case of obviousness is not established because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings is not satisfied (See *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002)). Specifically, neither Miyabayashi, nor Miki, express any suggestion or motivation to combine the two references to arrive at the claims of the present invention in question. Also, there is no likelihood or an expectation of success.

The Examiner respectfully disagrees with this argument. **Miyabayashi** et al teach that a thermosetting resin composition may be used for preparing precoated metals (See column 6, lines 47-50) by applying the **resin** composition to a metal substrate such as **alloyed zinc-plated steel** (See column 6, lines 54) after conventional **chromating** pre-treatment (See column 6, lines 59). The film also exhibits increased hardness as well as **high flexibility, stain resistance and chemical resistance** and can be utilized for, among others, **electrical appliances** (See column 7, lines 22-31). **Miki** et al teach that increasing requirements for more corrosion resistance than before in **automotive bodies and household electric appliances** are met by coating **zinc alloy-plated steel sheets with a chromate layer and resin film** (See column 1, lines 10-29). In other words, Miki et al is a secondary reference, which is relied upon to show that a method suitable for treating **household electric appliances** is also suitable for treating **automotive bodies**.

Thus, one of ordinary skill in the art would have been motivated and would have a reasonable expectation of success to apply a method of Miyabayashi et al suitable for household electric appliances for automotive bodies because Miki teaches that a method suitable for household electric appliances comprising steps of **coating zinc alloy-plated steel sheets with a chromate layer and resin film** is also suitable for automotive bodies.

Art Unit: 1762

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER
E Tsoy

June 7, 2006